

REMARKS/ARGUMENTS

In the Office Action mailed February 22, 2008, claims 1-18, 20, and 21 were rejected. In response, Applicant hereby requests reconsideration of the application in view of the below-provided remarks. No claims are amended, added, or canceled.

Claim Rejections under 35 U.S.C. 102 and 103

Claim 12 was rejected under 35 U.S.C. 102(b) as being anticipated by Key et al. (U.S. Pat. No. 6,272,621, hereinafter Key). Additionally, claims 1, 2, 3, 5-7, and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Key in view of Van Lunteren et al. (U.S. Pat. No. 7,193,997, hereinafter Van Lunteren). Additionally, claims 18, 20, and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Key in view of Kaganoi et al. (U.S. Pat. Pub. No. 2003/0012198, hereinafter Kaganoi). Additionally, claims 4, 5, and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Key, modified by Van Lunteren, and further in view of Khanna (U.S. Pat. No. 7,219,187, hereinafter Khanna). Additionally, claims 8 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Key, modified by Van Lunteren, and further in view of Kaganoi. Additionally, claims 13 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Key and in view of Kaganoi. Additionally, claims 14, 15, and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Key and in view of Van Lunteren. However, Applicant respectfully submits that these claims are patentable over Key, Van Lunteren, Kaganoi, and Khanna for the reasons provided below.

For convenience, Applicant's remarks begin with a discussion of the rejection of claim 12 in order to generally follow the order of the rejections presented in the Office Action.

Independent Claim 12

Claim 12 recites "wherein the first and second stage processing elements are configured to allow the second stage processing element to perform search-independent processing related to a packet in parallel with a search of the first stage memory unit, where the search is related to the same packet" (emphasis added).

In contrast, Key does not disclose performing search-independent processing at a second stage in parallel with a search of a first stage memory unit, as recited in the claim. In fact, the Office Action recognizes that Key does not explicitly disclose the indicated limitation. The Office Action recognizes this lack of explicit disclosure by Key because the Office Action asserts that it is allegedly inherent in Key to allow the second stage processing element to perform search-independent processing. However, this assertion is insufficient to support the rejection of claim 12 at least because the assertion of inherency is not properly supported by rationale or evidence, as required by the MPEP.

The MPEP states that the Examiner must provide rationale or evidence in order to show inherency. MPEP 2112(IV). More specifically, in relying on a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the assertion that an allegedly inherent characteristic necessarily flows from the teachings of the cited reference. Id. Moreover, the MPEP states that the possible occurrence of a result or characteristic is not sufficient to establish inherency of the asserted result or characteristic. Id.

Here, the Office Action merely restates some of the disclosure of Key related to feature processing applications such as encryption or data compression. In particular, the Office Action notes that the processing element (PE) stages may perform data encryption standard (DES) lookups and software functions. However, in light of the lack of disclosure by Key of performing lookups in one stage while performing search-independent processing in a different stage, the Office Action simply concludes that it is allegedly inherent in the disclosure of Key to allow a second stage PE to perform search-independent processing.

The conclusion of inherency asserted in the Office Action is not supported by any rationale or evidence. Although the Office Action concludes that search-independent processing in a second stage PE is allegedly inherent, the Office Action does not attempt to provide any rationale to explain why search-independent processing in a second stage PE might have been inherent. More specifically, the Office Action does not attempt to explain how the disclosure of only performing DES lookups and software functions, generally, might lead to the asserted conclusion of inherency. Additionally, the Office Action does not describe any facts or technical reasoning that would support the assertion

of inherency. Moreover, the Office Action does not provide any extrinsic evidence to remedy this lack of rationale. In other words, the Office Action asserts the unsupported conclusion of inherency, without providing any rationale or evidence to show how the Examiner might have arrived at the asserted conclusion of inherency.

Furthermore, as a separate basis of traversal, it should be noted that the actual disclosure of Key does not support the assertion of inherency because the actual disclosure of Key consistently describes the PE stages as being sequenced to ensure that each stage completes processing prior to starting a new pipeline stage. Key, col. 4, lines 30-34; col. 11, lines 20-23. In fact, Key describes specific logic, the row synchronization logic (RSL) 800, which receives processing completion status from each PE stage prior to advancing the pipelines. Key, col. 11, lines 30-31. To ensure this sequential processing among stages of each pipeline, the PE stages assert processing completion signals (proc_done) after each PE stage is done processing, and the next PE stages do not begin processing until a beginning of next phase signal (start_phase) is subsequently issued. Key, col. 11, lines 32-49. Thus, the processing of data at each PE stage within a pipeline is sequenced so that only one PE stage processes data at a time within a pipeline. Consequently, the explicit disclosure of Key does not support the Office Action's assertion of inherency because the assertion that it is allegedly inherent in Key to allow a second stage PE to perform search-independent processing is inconsistent with the actual disclosure of Key.

Therefore, Key does not disclose all of the limitations of the claim because the assertion of inherency is inconsistent with the actual disclosure of Key. Additionally, the rejection based on inherency is improper because the assertion of inherency is not properly supported by rationale or evidence as required by the MPEP. Accordingly, Applicant respectfully submits claim 12 is patentable over Key because Key does not disclose all of the limitations of the claim.

Independent Claims 1, 6, and 18

Applicant respectfully asserts independent claims 1, 6, and 18 are also patentable over Key, whether alone or in combination with Van Lunteren or Kaganoi, at least for similar reasons to those stated above in regard to the rejection of independent claim 12.

The rejections of independent claims 1, 6, and 18 rely on the same reasoning that is traversed above in regard to the rejection of independent claim 12.

Here, although the language of claims 1, 6, and 18 differs from the language of claim 12, and the scope of each of claims 1, 6, and 18 should be interpreted independently of claim 12, Applicant respectfully asserts that the remarks provided above in regard to the rejection of claim 12 also apply to the rejections of claims 1, 6, and 18. Accordingly, Applicant respectfully asserts claims 1, 6, and 18 are patentable over Key, whether alone or in combination with Van Lunteren or Kaganoi, because Key does not explicitly or inherently teach all of the limitations of the claims.

Dependent Claims

Claims 2-5, 7-11, 13-17, 20, and 21 depend from and incorporate all of the limitations of the corresponding independent claims 1, 6, 12, and 18. Applicant respectfully asserts claims 2-5, 7-11, 13-17, 20, and 21 are allowable based on allowable base claims. Additionally, each of claims 2-5, 7-11, 13-17, 20, and 21 may be allowable for further reasons.

CONCLUSION

Applicant respectfully requests reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-3444** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **50-3444** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

/mark a. wilson/

Date: May 20, 2008

Mark A. Wilson

Reg. No. 43,994

Wilson & Ham
PMB: 348
2530 Berryessa Road
San Jose, CA 95132
Phone: (925) 249-1300
Fax: (925) 249-0111